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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/679,510

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Peter H. Clarkson

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ACCENTURE, LLP

C/O HOGAN & HARTSON, LLP (IPGROUP)

555 13TH STREET NW, SUITE 600E

WASHINGTON, DC 20004

EXAMINER

TARAE, CATHERINE MICHELLE

ART UNIT

PAPER NUMBER

3623

NOTIFICATION DATE

DELIVERY MODE

02/22/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dcptopatent@hhlaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/679,510	<b>Applicant(s)</b> CLARKSON, PETER H.	
	<b>Examiner</b> C. Michelle Tarae	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The following is a Non-Final Office Action in response to the communication received on October 7, 2003. Claims 1-17 are now pending in this application.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Myrick et al. (U.S. 7,162,427).

As per claim 1, Myrick et al. discloses a method for calculating benefits to a public sector entity from a technology expenditure, the method comprising the steps of:

(a) classifying one or more activities of the public sector entity, wherein said classifying is specifically configured to said public sector entity (col. 3, line 66-col. 4, line 4; col. 14, lines 17-36; Figure 6; An organization's architecture is dependent on the line of business the organization is in, including being affected by government legislation and regulations. The strategic planning process determines actions, or activities, of the resources of the organization.);

(b) determining a plan for implementing the technology expenditure (col. 4, lines 33-52; col. 7, lines 45-57; Figures 2-4; A plan is determined for developing IT solutions that will affect the organization's activities, or business processes.); and

(c) determining the net effect on each of the activities from said plan for implementing the technology expenditure (col. 8, lines 43-55; Impact of the IT plan on how the organization does business is determined.).

As per claim 2, Myrick et al. discloses the method of claim 1, wherein the activities of the public sector entity selected from a function selected from a group consisting of: Strategic Management; Financial Management; Revenue Management; Human Resource Management; Resource Management; Procurement & Supply Chain Management; Facilities & Asset Management; Customer Relationship Management; Program and Case Management; Corporate Data Management; Systems Management; and e-Government Management (col. 14, line 17-col. 15, line 9).

As per claim 3, Myrick et al. discloses the method of claim 1, wherein the step of classifying one or more activities of the public sector entity comprises the steps of:

forming a detailed functioning mapping (Figure 7); and

creating a value driver (col. 17, lines 17-34; Figure 14-16 and 23).

As per claim 4, Myrick et al. discloses the method of claim 3, wherein the step of forming detailed functioning mapping further comprises the steps of:

functional mapping, process group mapping, process mapping, and activity mapping (Figures 7 and 29).

As per claim 5, Myrick et al. discloses the method of claim 3, wherein the step of developing a value driver further comprises the steps of:

developing a value driver (col. 17, lines 17-34; Figure 14-16 and 23);

developing a transformation benefit and developing a technology expenditure benefit (col. 14, lines 37-47; The function/process model supports identifying how business processes would benefit from IT solutions, including identifying competitive advantages.).

As per claim 6, Myrick et al. discloses the method of claim 1, wherein the step of determining a plan for implementing the technology expenditure comprises the steps of:

integrating a benefits framework and developing a benefits delivery plan (col. 14, lines 37-47; Figure 2; The function/process model supports identifying how business processes would benefit from IT solutions, including identifying competitive advantages. Transition plans are developed to deliver particular IT solutions.).

As per claim 7, Myrick et al. discloses the method of claim 6, wherein the step of integrating a benefits framework further comprises the steps of:

adjusting a benefits framework to the technology expenditure and integrating the adjusting a benefits framework with a technology expenditure implementation (col. 9, lines 30-36; col. 15, line 65-col. 16, line 17; Figure 10; The expenditure profile is adjusted to meet the IT solutions implementation needs.).

As per claim 8, Myrick et al. discloses the method of claim 6, wherein the step of developing a benefits delivery plan further comprises the steps of:

developing a detailed benefit delivery plan, approving said detailed benefit delivery plan, and forming an organizational benefits program (col. 14, lines 37-47; Figure 2; The function/process model supports identifying how business processes would benefit from IT solutions, including identifying competitive advantages. Transition plans are developed to deliver particular IT solutions.).

As per claim 9, Myrick et al. discloses the method of claim 1, wherein the step of determining the net effect on each of the activities further comprises the steps of:

benchmarking total costs, developing a achievement target, accessing a probability range, and determining an expected benefit (col. 15, line 65-col. 16, line 17; Figures 10-11).

As per claim 10, Myrick et al. discloses the method of claim 1 further comprising the step of monitoring the activities to determine compliance of the public sector entity with the plan (col. 8, lines 22-42; col. 14, lines 26-36; col. 27, lines 1-9; The IT solutions are implemented so that they comply with various instituted policies and standards.).

As per claim 11, Myrick et al. discloses the method of claim 10, wherein the step of monitoring the activities further comprises the steps of:

implementing a benefit delivery plan and monitoring benefits realization (col. 14, lines 37-47; Figure 2; The function/process model supports identifying how business processes would benefit from IT solutions, including identifying competitive advantages. Transition plans are developed to deliver particular IT solutions.).

Claims 12-17 recite the corresponding system and program storage device to the method claims 1-11 already rejected above. Therefore, claims 12-17 are rejected on the same basis as claims 1-11 above.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Bond (U.S. 6,738,736) discusses capacity planning and modeling;
- Macrae (U.S. 2003/0093310) discusses a business management process;
- Buteau et al. (U.S. 6,442,557) discusses evaluation of enterprise architecture modeling.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/C. Michelle Tarae/  
Primary Examiner, Art Unit 3623

February 15, 2008